

REMARKS

Claims 19-26 and 28-29 are pending in the application.

The Outstanding Rejections

The Examiner rejected claims 19-26 and 28-29 under 35 U.S.C. §112, second paragraph as allegedly being indefinite.

Claims 19-26 and 28-29 were also rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,476,211 B1 (herein referred to as the '211 patent).

Finally, claims 19-26 and 28-29 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Smith *et al.* in view of Harlow *et al.* or Campbell *et al.*

Amendments to the Specification

In order to comply with the general standards for drawings under 37 C.F.R. §1.84, each one of Figures 1-9 have been separated into multiple figures (*e.g.* Figure 1 has been separated into Figures 1A, 1B, 1C, 1D, 1E, and 1F). Lines of text in the specification indicating precisely where replacement paragraphs are to be added were determined by counting down from the top of each page, and not by using the numbers in the left margin, which do not accurately correspond to the respective lines. Figures 2, 3, 8, and 9 (now Figs. 2A, 2B, 2C; 3A, 3B, 3C, 3D; 8A, 8B, 8C, 8D; and 9A, 9B, 9C, 9D, and 9E, respectively) have also been amended by double-underlining identical residues (originally having dark background), and single-underlining conserved residues (originally having gray background). Amendments to corresponding paragraphs of the specification also reflect these changes. Spaces in the sequences in these same figures, originally indicated by dots, have also been amended to be reflected as dashes. Additionally, in Figure 3 (now Figs. 3A, 3B, 3C, and 3D), “chickATPase” has been amended to “chiATPase” in order for the figures to comply with the margin requirements of 37 C.F.R. §1.84(g). Finally, Figures 2, 8, and 9 (now Figs. 2A, 2B, 2C; 8A, 8B, 8C, 8D; and 9A, 9B, 9C, 9D, and 9E, respectively) have also been amended by deleting dashes at the ends of the sequences (C-terminal) depicted therein, which is clear from the final amino acid residue depicted for each sequence.

Patentability Arguments

1. 35 U.S.C. §112, second paragraph Rejection

The Examiner rejected claims 19-26 and 28-29 under 35 U.S.C. §112, second paragraph. Applicants have amended the claims following the Examiner's suggestions. In light of the amended claims, Applicants respectfully request that the 35 U.S.C. §112 rejections be withdrawn.

2. 35 U.S.C. §102(e) Rejection

The Examiner rejected claims 19-26 and 28-29 in view of the '211 patent alleging that the '211 patent teaches CD39L2 antibodies. Applicants submit that the '211 patent teaches antibodies that recognize only amino acid residues 121-134 of CD39L2. Therefore, Applicants have amended the claims to exclude CD39L2 antibodies that bind to amino acid residues 121-134 of CD39L2. In light of the amended claims, Applicants respectfully request that the 35 U.S.C §102(e) rejection be withdrawn.

3. 35 U.S.C. §103(a) Rejection

The Examiner rejected claims 19-26 and 28-29 using Smith *et al.* (the Smith reference) in view of Harlow *et al.* or Campbell *et al.* Applicants respectively disagree. The Examiner alleges that the cited references render the instant invention obvious by the disclosure of a CD39L2-like polypeptide in the Smith reference. However Applicants were in possession of the polypeptide of SEQ ID NO: 2 prior to the publication date of the Smith reference [Chadwick and Frischauf, *Genomics* 50:357-367 (1998)]. The Rule 1.131 showing submitted herein in Exhibit A (herein referred to as the Funk Declaration) shows that Applicants were in possession of the polypeptide of SEQ ID NO: 2 at least as early as June 15, 1998 which precedes the publication date of the Smith reference (July 1998). In *In re Stempel* [(241 F.2d 755, 113 USPQ 77 (CCPA 1957)], the CCPA concluded "that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the references [sic] happens to show. When he has done that he has disposed of the references." In addition, the decision of *In re Stryker* [(435

F.2d 1340, 168 USPQ 372 (CCPA 1971)] indicated that a §103 reference can be overcome by antedating the pertinent disclosure of the reference without regard to the invention as claimed. Therefore, Applicants have shown in the Funk Declaration that they were in possession of all that was known in the art at the time of filing, namely the polypeptide of SEQ ID NO: 2; thus the Smith reference should be eliminated thereby mooting the rejection under 35 U.S.C. §103(a). Furthermore, the Chadwick *et al.*, paper does not constitute a bar under 35 U.S.C. §102(b) in that it was published less than one year before the effective filing date of the instant application. In light of the aforementioned remarks, Applicants respectfully request that the 35 U.S.C. §103(a) rejection be withdrawn.

CONCLUSION

On the basis of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims are in condition for allowance, and a Notice of Allowance is respectfully requested as soon as possible. If there are any questions regarding these amendments and remarks, or if further discussion would expedite allowance of the claims, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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